

REMARKS

Claims 1-20 were pending in the Application. Applicants cancelled claim 20 without prejudice or disclaimer. Hence, claims 1-19 are pending.

The drawings are objected to. Claims 1-13 and 20 are rejected under 35 U.S.C. §101. Claims 1, 2, 11, 14 and 19 are rejected under 35 U.S.C. §102(e). Claims 3-10 and 15-18 are rejected under 35 U.S.C. §103(a). Applicants address these objections and rejections below.

Applicants thank the Examiner for discussing the Office Action with Applicants' attorney on December 7, 2006.

I. OBJECTIONS TO THE DRAWINGS:

The Examiner has objected to the drawings for failing to comply with 37 C.F.R. §§1.84(p)(4) and (5). Office Action (9/29/2006), page 2. In particular, the Examiner objects to reference character "207" as allegedly designating "both the step of selection order object and a step of updating selection order object." *Id.* Applicants respectfully traverse and assert that element 207 corresponds to simply the selection order object as discussed on page 9, lines 1-19 of Applicants' Specification. Element 207 does not represent updating.

Further, the Examiner objects to the drawings because reference character "203" has allegedly been used to designate "both a step of quoting parent order object...and an item of a quotation parent order object." *Id.* Applicants respectfully traverse and assert that element 203 simply corresponds to a quotation parent object. Element 203 does not correspond to an item of a quotation parent object.

Further, the Examiner objects to the drawings because reference character "212" has been used to designate both an order tracking process and an inventory report process. *Id.* Applicants amended the Specification, as indicated above, to replace "inventory report process 212" with "inventory report process 214."

Further, the Examiner objects to the drawings because reference characters "260" and "270" have been used to designate an inventory report and a table showing the history of inventory adjustments. *Id.* Further, the Examiner objects to the drawings because Figure 12 does not include the reference characters "280" and

"290" which were discussed in the Specification. Applicants amended Figure 12, as indicated above, by replacing reference character "260" with reference character "280" as well as replacing reference character "270" with reference character "290." Applicants believe this amendment addresses these Examiner's objections.

Further, the Examiner objects to the drawings because reference characters "602," "1002," "1008," and "1009" are allegedly not discussed in the Specification. Office Action (9/29/2006), page 3. Applicants respectfully direct the Examiner's attention to page 13, line 4 of the Specification where element 602 is discussed. Applicants further direct the Examiner's attention to page 17, line 9 of the Specification where element 1002 is discussed. Applicants amended the Specification, as indicated above, to include a reference to element numbers 1008 and 1009.

As a result of the foregoing, Applicants respectfully request the Examiner to withdraw the objections to the drawings.

II. REJECTIONS UNDER 35 U.S.C. §101:

The Examiner rejects claims 1-13 and 20 under 35 U.S.C. §101 because the claimed inventions are allegedly directed to non-statutory subject matter. Office Action (9/29/2006), page 3.

In particular, the Examiner rejects claims 1-13 under 35 U.S.C. §101 because claims 1-13 are allegedly directed to a 'commerce site.' *Id.* Per the Examiner's suggestion, as indicated in a telephone conference with Applicants' attorney on December 7, 2006, Applicants amended claims 1-13 to include the aspect of a computer system hosting a commerce site in order to expedite the prosecution of this case. Applicants note that these amendments were not made to overcome prior art but to clarify the claimed subject matter. Hence, no prosecution history estoppel arises from the amendments to claims 1-13. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-12 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendments made to claims 1-13 were not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from such amendments. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707

(2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

While Applicants amended claims 1-13 to expedite the prosecution of this case as indicated above, Applicants respectfully traverse the basis of the 35 U.S.C. §101 rejections as indicated below.

The Congressional intent, is that any new and useful process, machine, manufacture or composition of matter under the sun that is made by man is the proper subject matter of a patent. M.P.E.P. §2106. The subject matter courts have found to be outside the four statutory categories is limited to subject matter that is not a practical application or use of an idea, a law of nature or a natural phenomenon. *See, e.g., Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507 (1874); M.P.E.P. §2106. Claims 1-13 are directed to a commerce site for exchanging commerce information with a plurality of remote store sites and shopper clients over a computer network.

Applicants respectfully contend that the claimed inventions in claims 1-13 satisfy the test for statutory subject matter recited in *In re Alappat*, and repeated in *State Street Bank & Trust Co. v. Signature Financial Group*, and *AT&T Corp. v. Excel Communications, Inc.* *In re Alappat*, 33 F.3d 1526, 31 U.S.P.Q.2d 1545 (Fed. Cir. 1994); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 47 U.S.P.Q.2d 1596 (Fed. Cir. 1998); *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1526, 50 U.S.P.Q.2d 1547 (Fed. Cir. 1999). The claimed inventions produce a useful, concrete and tangible result in, *inter alia*, exchanging commerce information with a plurality of remote store sites and shopper clients over a computer network.

The essential inquiry under *In re Alappat* is to determine whether the claimed subject matter as a whole is directed to a disembodied mathematical concept representing nothing more than a "law of nature" or an "abstract idea" or if, in contrast, the mathematical concept has been reduced to some practical application rendering it useful. *AT&T Corp.*, 172 F.2d at 1357, 50 U.S.P.Q.2d at 1451 (citing *In re Alappat*, 33 F.3d at 1543, 31 U.S.P.Q.2d at 1556-57). Moreover, in making the determination whether the claimed subject matter as a whole is a disembodied

mathematical concept or if the concept has been reduced to some practical application rendering it useful, the claims must be construed in the light of the Specification. *See, AT&T Corp.*, 172 F.3d at 1357, 50 U.S.P.Q.2d at 1451 (stating that more than an abstract idea was claimed in *In re Alappat* because the "claimed invention as whole was directed toward forming a specific machine that produced the useful, concrete and tangible result of a *smooth wave form display*") (emphasis supplied). The single claim at issue in *In re Alappat* was directed to a rasterizer and recited elements in means plus function form. *In re Alappat*, 33 F.3d at 1540, 31 U.S.P.Q.2d at 1555. Additionally, none of the limitations recited in the claim at issue expressly claimed a "smooth wave form display". Indeed, the concrete, useful and tangible result relied upon in *In re Alappat*, namely, a smooth uniform display, appears in the background of the invention. *Kuriappan P. Alappat, et al.*, U.S. Patent No. 5,440,676 (col. 1, lines 9-10).

Likewise, in *AT&T Corp.*, the useful, nonabstract result relied upon in holding that the claimed invention was directed to statutory subject matter was that the PIC indicator therein held information about the call recipients PIC, which facilitated differential billing of long-distance calls made by a subscriber. *AT&T Corp.*, 172 F.3d 1358, 50 U.S.P.Q.2d at 1452. However, the claim at issue in *AT&T Corp.* was directed to a method including the steps of generating a message record for an interexchange call, and including in the message record a PIC indicator having a value which is a function of whether or not the interexchange carrier associated with the terminating subscriber is a predetermined one of the interexchange carriers. *AT&T Corp.*, 172 F.3d at 1354, 50 U.S.P.Q.2d at 1449. Again, there was no express or explicit claim limitation directed to the useful, concrete, and tangible result relied upon in determining that the aforesaid claim was directed to statutory subject matter. *See, Id.* The relied upon PIC indicator that facilitates differential billing of long-distance calls appears, *inter alia*, in the summary of the invention. *Gerard P. Doherty, et al.*, U.S. Patent No. 5,333,184, col. 1, line 66 through col. 2, line 3.

Likewise, in *State Street Bank & Trust v. Signature Financial Group*, a useful and concrete and tangible result not expressed in an explicit limitation in the claim at issue was relied upon in holding that the claim was directed to statutory subject matter. *See, State Street Bank*, 149 F.3d at 1373, 47 U.S.P.Q.2d at 1601 (holding that

the transformation of data by the claimed data processing system produced a useful, concrete and tangible result, namely a final share price momentarily fixed for recording and reporting purposes). The claimed invention recited no limitation directed to either a final share price or means for momentarily fixing the final share price for recording and reporting purposes. *See, State Street Bank*, 149 F.3d at 1371, 47 U.S.P.Q.2d at 1599. Indeed, the relied upon useful, concrete and tangible result in *State Street Bank*, namely a final share price momentarily fixed, is not explicitly recited in the *State Street Bank* patent, but is effectively a distillation of the Summary of the Invention. *See, R. Todd Boes*, U.S. Patent No. 5,193,056, col. 4, lines 36-61. Thus, it is beyond peradventure that when judging the claimed subject matter as a whole to determine patentability under 35 U.S.C. §101, the claims must be construed in the light of the specification.

In short, the question whether a claim encompasses statutory subject matter focuses on the essential characteristics of the subject matter, in particular its utility. *State Street Bank*, 149 F.3d at 1375, 47 U.S.P.Q.2d at 1602.

Claims 1-13 encompass statutory subject matter as they clearly produce a useful, tangible result. For example, claim 1 is directed to a commerce site for exchanging commerce information with a plurality of remote store sites and shopper clients over a computer network, the commerce site comprising: a marketplace store for exchanging information with shopper clients and remote store sites through the computer network; and a plurality of proxy stores, each proxy store associated with one of remote store sites for communicating therewith over the computer network and acting as an intermediary for information exchanged between the associated remote store site and the marketplace store.

As stated above, the inquiry under 35 U.S.C. §101 is whether there is a practical application, or result. *State Street Bank*, 149 F.3d at 1373, 47 U.S.P.Q.2d at 1601. As discussed above, claims 1-13 is directed a commerce site for exchanging commerce information with a plurality of remote store sites and shopper clients over a computer network. Hence, the subject matter of claims 1-13 has a practical application within the four statutory categories and is not an idea, a law of nature or a natural phenomenon.

As understood by Applicants, the Examiner's basis for rejecting claims 1-13 under 35 U.S.C. §101 is because the Examiner concludes that claims 1-13 are directed to a commerce site which is merely a compilation of data and then concludes it is not statutory in light of *In re Wamerdam*. Office Action (9/29/2006), pages 3-4. Applicants respectfully traverse.

In re Wamerdam dealt with the issue of whether a method of generating a data structure was patentable. 31 U.S.P.Q.2d 1754, 1756 (Fed. Cir. 1994). The Federal Circuit's analysis of whether a method of generating a data structure was patentable focused on whether the claim is for a process that goes beyond simply manipulating "abstract ideas" or "natural phenomena." *Id.* at 1759. The Federal Circuit concluded that the steps of the claim in question ('locating' a medical axis, and 'creating' a bubble hierarchy) were no more than a manipulation of basic mathematical constructs, the paradigmatic 'abstract idea.' *Id.*

However, the claim limitations in claim 1 do not manipulate basic mathematic constructs. On the contrary, claim 1 recites "a marketplace store for exchanging information with shopper clients and remote store sites through the computer network." Claim 1 further recites "a plurality of proxy stores, each proxy store associated with one of the remote store sites for communicating therewith over the computer network and acting as an intermediary for information exchanged between the associated remote store site and the marketplace store." Clearly, claim 1 goes beyond simply manipulating "abstract ideas" or "natural phenomena." As a result, using the analysis of *In re Wamerdam*, which was cited by the Examiner as support for the Examiner's assertion that claims 1-13 do not constitute statutory subject matter, clearly indicate that claims 1-13 do indeed constitute statutory subject matter.

Further, Applicants respectfully traverse the assertion that a commerce site is nothing more than a compilation of data without sufficient structure. As indicated by claim 1, the commerce site includes a marketplace store and a plurality of proxy stores.

Thus, Applicants respectfully contend that claims 1-13, as originally filed, constitute statutory subject matter.

Further, the Examiner rejects claim 20 under 35 U.S.C. §101 because claim 20 allegedly does not fall within the statutory classes of 35 U.S.C. §101. *Id.* Applicants cancelled claim 20 and hence the rejection to claim 20 is moot.

III. REJECTIONS UNDER 35 U.S.C. §102:

The Examiner has rejected claims 1, 2, 11, 14 and 19 under 35 U.S.C. §102(e) as being anticipated by Wharton (U.S. Patent Application Publication No. 2005/0027611). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request the Examiner to reconsider and withdraw these rejections.

For a claim to be anticipated under 35 U.S.C. §102, each and every claim limitation must be found within the cited prior art reference and arranged as required by the claim. M.P.E.P. §2131.

Applicants further assert that Wharton does not disclose "the commerce site comprising: a marketplace store for exchanging information with shopper clients and remote store sites through the computer network" as recited in claim 1 and similarly in claims 14 and 19. The Examiner cites paragraph [0026] of Wharton as disclosing the above-cited claim limitation. Office Action (9/29/2006), page 6. The Examiner further asserts that the electronic mall, as disclosed by Wharton, discloses a marketplace store. Applicants respectfully traverse and assert that Wharton instead discloses that vendor commerce systems 34, 36 and 38 may be aggregated into an 'electronic mall' 56, by coupling the vendor commerce systems 34, 36, 38 to one or more e-commerce portal(s) 32. [0026]. Hence, Wharton discloses aggregating commerce systems 34, 36 and 38 into an electronic mall.

There is no language in the cited passage that discloses a commerce site that comprises electronic mall 56 (Examiner asserts that electronic mall 56 of Wharton discloses a marketplace store). Applicants respectfully request the Examiner to particularly point out in Figure 1 of Wharton where Wharton discloses such a commerce site pursuant to 37 C.F.R. §1.104(c)(2). Further, there is no language in the cited passage that discloses that electronic mall 56 exchanges information with shopper clients and remote store sites through the computer network. Applicants respectfully request the Examiner to particularly point out in Figure 1 of Wharton

where Wharton discloses the remote store sites pursuant to 37 C.F.R. §1.104(c)(2). Hence, Wharton does not disclose all of the limitations of claims 1, 14 and 19, and thus Wharton does not anticipate claims 1, 14 and 19. M.P.E.P. §2131.

Applicants further assert that Wharton does not disclose "a plurality of proxy stores, each proxy store associated with one of the remote store sites for communicating therewith over the computer network and acting as an intermediary for information exchanged between the associated remote store site and the marketplace store" as recited in claim 1. The Examiner cites paragraphs [0026-0027] of Wharton as disclosing the above-cited claim limitation. Office Action (9/29/2006), page 6. The Examiner further states that the "proxies are the e-commerce portals through which vendors are coupled." *Id.* Applicants respectfully traverse.

Wharton instead discloses that vendor commerce systems 34, 36 and 38 may be aggregated into an 'electronic mall' 56, by coupling the vendor commerce systems 34, 36, 38 to one or more e-commerce portal(s) 32. [0026]. Wharton further discloses that by aggregating the vendor systems through the e-commerce portal 32, a more unified shopping experience is established. [0027]. Wharton additionally discloses that a particular portal 32 may provide a common graphical user-interface to numerous vendor commerce systems 34, 36, 38, just like a regular mall. [0027]. Hence, Wharton discloses a portal 32 that provides a common graphical user-interface to vendor commerce system 34, 36, 38.

Applicants respectfully traverse the assertion that portal 32 of Wharton is a plurality of proxy stores. The Examiner's interpretation of proxy stores is inconsistent with the Specification. The Examiner must provide a basis in fact and/or technical reasoning to support the assertion that portal 32 of Wharton is a plurality of proxy stores. *See Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that portal 32 of Wharton is a plurality of proxy stores, and that it would be so recognized by persons of ordinary skill. *See In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Further, the pending claims must be given their broadest reasonable interpretation consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372, 54 U.S.P.Q.2d 1664, 1667 (Fed. Cir. 2000); M.P.E.P. §2111. The broadest reasonable interpretation

of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); M.P.E.P. §2111. Since the Examiner has not provided a reasonable interpretation consistent with the specification or consistent with the interpretation that those skilled in the art would reach, the Examiner has not presented a *prima facie* case of anticipation for rejecting claim 1. M.P.E.P. §2111.

Further, even assuming *arguendo* that portal 32 discloses a proxy store, Wharton discloses a single portal 32. Claim 1 recites a plurality of proxy stores. Further, there is no language in the cited passages that discloses that portal 32 is associated with one of the remote store sites for communicating therewith. Neither is there any language in the cited passages that discloses that portal 32 is associated with one of the remote store sites for communicating therewith over the computer network. Neither is there any language in the cited passages that discloses that portal 32 is associated with one of the remote store sites for communicating therewith over the computer network and acting as an intermediary for information exchanged between the associated remote store site and electronic mall 56¹ (Examiner asserts that electronic mall 56 discloses a marketplace store). Hence, Wharton does not disclose all of the limitations of claim 1, and thus Wharton does not anticipate claim 1. M.P.E.P. §2131.

Applicants further assert that Wharton does not disclose "providing at the commerce site a plurality of proxy stores, each proxy store representing an associated remote store site" as recited in claim 14. The Examiner cites portal 32 of Wharton as disclosing a plurality of proxy stores. Office Action (9/29/2006), page 6. Applicants respectfully traverse.

The Examiner must provide a basis in fact and/or technical reasoning to support the assertion that portal 32 of Wharton is a plurality of proxy stores. *See Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the

¹ It is noted that portal 32 is included within electronic mall 56 as illustrated in Figure 1 of Wharton and hence seems odd as to how portal 32, which is a separate element from the marketplace store, could act as an intermediary for information exchanged between the associated remote store site and electronic mall 56 (Examiner asserts that electronic mall 56 discloses a marketplace store).

Examiner must provide extrinsic evidence that must make clear that portal 32 of Wharton is a plurality of proxy stores, and that it would be so recognized by persons of ordinary skill. *See In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Since the Examiner has not provided such objective evidence, the Examiner has not established a *prima facie* case of anticipation in rejecting claim 14.

Further, the Examiner has not cited to any passage in Wharton that discloses providing at the commerce site a plurality of proxy stores, each proxy store representing an associated remote store site. How can portal 32 be each proxy store representing an associate remote store site? Thus, Wharton does not disclose all of the limitations of claim 14, and thus Wharton does not anticipate claim 14. M.P.E.P. §2131.

Applicants further assert that Wharton does not disclose "generating and storing at the marketplace commerce site, a parent order object that includes a parent list of parent items, each parent item identifying an associated asset selected by the shopper from the catalog" as recited in claim 14. The Examiner has not specifically addressed this limitation. The Examiner is reminded that in order to establish a *prima facie* case of anticipation, the Examiner must provide a single prior art reference that expressly or inherently describes each and every element as set forth in the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Since the Examiner has not addressed this limitation, the Examiner has not established a *prima facie* case of anticipation in rejecting claim 14. M.P.E.P. §2131.

Applicants further assert that Wharton does not disclose "generating first requests at selected proxy stores that are associated with remote store sites specified by the shopper first request, each of the selected proxy stores sending the first request generated thereby to its associated remote store over the network, the first requests each identifying assets identified in the parent list" as recited in claim 14. The Examiner has not specifically addressed this limitation. The Examiner is reminded that in order to establish a *prima facie* case of anticipation, the Examiner must provide a single prior art reference that expressly or inherently describes each and every element as set forth in the claim. *Verdegaal Bros. v. Union Oil Co. of*

California, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Since the Examiner has not addressed this limitation, the Examiner has not established a *prima facie* case of anticipation in rejecting claim 14. M.P.E.P. §2131.

Applicants further assert that Wharton does not disclose "computer executable instructions for implementing a marketplace store interface through which a shopper at the shopper client can select assets from the catalog, the marketplace store interface configured for generating and storing at the marketplace site, a parent order object that includes a parent list of parent items, each parent item identifying an associated asset selected by the shopper from the catalog" as recited in claim 19. The Examiner has not specifically addressed this limitation. The Examiner is reminded that in order to establish a *prima facie* case of anticipation, the Examiner must provide a single prior art reference that expressly or inherently describes each and every element as set forth in the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Since the Examiner has not addressed this limitation, the Examiner has not established a *prima facie* case of anticipation in rejecting claim 19. M.P.E.P. §2131.

Applicants further assert that Wharton does not disclose "computer executable instructions for implementing a plurality of proxy stores, each proxy store representing an associated remote store site, the proxy stores configured for generating associated first requests and sending the generated first requests to the remote store sites associated therewith, the first requests each identifying assets identified in the parent list" as recited in claim 19. The Examiner has not specifically addressed this limitation. The Examiner is reminded that in order to establish a *prima facie* case of anticipation, the Examiner must provide a single prior art reference that expressly or inherently describes each and every element as set forth in the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Since the Examiner has not addressed this limitation, the Examiner has not established a *prima facie* case of anticipation in rejecting claim 19. M.P.E.P. §2131.

Claims 2 and 11 each recite combinations of features of independent claim 1 and hence claims 2 and 11 are not anticipated by Wharton for at least the above-stated

reasons that claim 1 is not anticipated by Wharton. Claims 2 and 11 recite additional features, which, in combination with the features of the claims upon which they depend, are not anticipated by Wharton.

For example, Wharton does not disclose "the marketplace store has access to the catalog for creating a parent list identifying assets selected from the catalog by one of the shopper clients over the network" as recited in claim 2. The Examiner cites paragraph [0030] of Wharton as disclosing the above-cited claim limitation. Office Action (9/29/2006), page 6. The Examiner states that the global shopping basket of Wharton discloses the parent list. *Id.* The Examiner has further cited to paragraphs [0027 and 0037] of Wharton as disclosing the catalog in the above-cited claim limitation. *Id.* Applicants respectfully traverse.

Wharton instead discloses that the global shopping basket 14 is coupled to the ICC transaction processor 12. [0030]. Wharton further discloses that the global shopping basket 14 aggregates transaction information from numerous vendor commerce systems during a customer's shopping session. [0030]. Wharton additionally discloses that e-commerce portal 32 may include a searchable cross-vendor index that includes listings of all (or some) of the products being sold by all (or some) of the vendors connected through the e-commerce portal 32. [0037]. Hence, Wharton discloses an ICC transaction processor 12 that aggregates transaction information from numerous vendor commerce systems during a customer's shopping session into global shopping basket 14 as illustrated in Figure 1. Wharton further discloses that portal 32 may include a searchable cross-vendor index that includes listings of all (or some) of the products being sold by all (or some) of the vendors.

Hence, electronic mall 56 (Examiner asserts that electronic mall 56 discloses the marketplace store) does not create global shopping basket 14 (Examiner asserts that global shopping basket 14 discloses a parent list). Instead, ICC transaction processor 12, separate from electronic mall 56, creates global shopping basket 14. Further, there is no language in the cited passages that discloses that electronic mall 56 (Examiner asserts that electronic mall 56 discloses the marketplace store) has access to the searchable cross-vendor index of portal 32 (Examiner asserts that cross-vendor index discloses the catalog) for creating global shopping basket 14. Neither is

there any language in the cited passages that discloses that electronic mall 56 (Examiner asserts that electronic mall 56 discloses the marketplace store) has access to the searchable cross-vendor index of portal 32 (Examiner asserts that cross-vendor index discloses the catalog) for creating global shopping basket 14 identifying assets selected from the index by one of the shopper clients over the network. Thus, Wharton does not disclose all of the limitations of claim 2, and thus Wharton does not anticipate claim 2. M.P.E.P. §2131.

Applicants further assert that Wharton does not disclose "each proxy store is configured for reading the parent list and creating a first request identifying at least some of the assets in the parent list and sending the first request over the computer network to the remote store site associated therewith" as recited in claim 2. The Examiner cites paragraphs [0032-0033] of Wharton as disclosing the above-cited claim limitation. Office Action (9/29/2006), page 6. Applicants respectfully traverse and assert that Wharton instead discloses that vendor commerce systems 34, 36, 38 are programmed to communicate transaction information to the ICC transaction processor 12 using a universal transaction interface comprising transaction packets 44. [0032]. Wharton further discloses that the ICC transaction processor 12 then stores this information in the global basket 14, pending global checkout by the customer 42. [0032]. There is no language in the cited passages that discloses each proxy store. Neither is there any language in the cited passages that discloses each proxy store is configured for reading the parent list. Neither is there any language in the cited passages that discloses each proxy store is configured for reading the parent list and creating a first request identifying at least some of the assets in the parent list. Neither is there any language in the cited passages that discloses each proxy store is configured for reading the parent list and creating a first request identifying at least some of the assets in the parent list and sending the first request over the computer network to the remote store site associated therewith. Thus, Wharton does not disclose all of the limitations of claim 2, and thus Wharton does not anticipate claim 2. M.P.E.P. §2131.

Applicants further assert that Wharton does not disclose "wherein the marketplace catalog, marketplace store and the proxy stores are all resident on a common computer coupled to the computer network" as recited in claim 11. The

Examiner cites paragraph [0026] of Wharton as disclosing the above-cited claim limitation. Office Action (9/29/2006), page 7. Applicants respectfully traverse and assert that Wharton instead discloses that vendor commerce systems 34, 36 and 38 may be aggregated into an 'electronic mall' 56, by coupling the vendor commerce systems 34, 36, 38 to one or more e-commerce portal(s) 32. [0026]. Hence, Wharton discloses aggregating commerce systems 34, 36 and 38 into an electronic mall. There is no language in the cited passage that discloses that the marketplace catalog, marketplace store and the proxy stores are all resident on a common computer coupled to the computer network. Thus, Wharton does not disclose all of the limitations of claim 11, and thus Wharton does not anticipate claim 11. M.P.E.P. §2131.

As a result of the foregoing, Applicants respectfully assert that not each and every claim limitation was found within Wharton, and thus claims 1, 2, 11, 14 and 19 are not anticipated by Wharton. M.P.E.P. §2131.

IV. REJECTIONS UNDER 35 U.S.C. §103(a):

The Examiner has rejected claims 3-10, 12 and 15-17 under 35 U.S.C. §103(a) as being unpatentable over Wharton in view of King et al. (U.S. Patent Application Publication No. 2002/0152133) (hereinafter "King"). The Examiner has further rejected claims 13 and 18 under 35 U.S.C. §103(a) as being unpatentable over Wharton in view of Palmer et al. (U.S. Patent Application Publication No. 2002/0107763) (hereinafter "Palmer"). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request the Examiner to reconsider and withdraw these rejections.

A. Claims 3-10, 12 and 15-17 are patentable over Wharton in view of King.

1. Wharton and King, taken singly or in combination, do not teach or suggest the following claim limitations.

Applicants respectfully assert that Wharton and King, taken singly or in combination, do not teach or suggest "wherein each proxy store is configured for (a) receiving an associated initial quote response from its associated remote store site in

reply to the first request, the initial quote response identifying at least some of the assets identified in the first request and associated prices, and (b) creating an associated initial quote list identifying the assets and associated prices identified in the initial quote response, the commerce site including an interface for presenting to the shopper client the initial quote lists associated with a plurality of the proxy stores" as recited in claim 3. The Examiner cites paragraphs [0080-0083] of King as teaching the above-cited claim limitations. Office Action (9/29/2006), pages 8-9. Applicants respectfully traverse.

King instead teaches that to initiate an order, a registered buyer logs on to the marketplace 10, such as through the portal or website, using an industry standard Internet browser. [0080]. King further teaches that once on the marketplace 10, the buyer selects the ordering function. [0080]. King further teaches that the buyer submits the completed order, referred to as a 'Req Check' or a Price and Availability (P&A) Check, as an XML message to the marketplace 10. [0080]. King additionally teaches that the marketplace 10 receives the Req Check and records the line items from the Req Check, so that the marketplace 10 can maintain the status of the buyer's order. [0081]. Furthermore, King teaches that the supplier manually or automatically responds to the Req Check. [0082]. Additionally, King teaches that the supplier creates an XML Req Check Response message and sends the message to the Omnexus Marketplace. [0082]. King further teaches that once received by the marketplace, the marketplace assesses the status of the message. [0083].

There is no language in the cited passages that teaches that each proxy store is configured for receiving an associated initial quote response from its associated remote store site. Neither is there any language in the cited passages that teaches that each proxy store is configured for receiving an associated initial quote response from its associated remote store site in reply to the first request. Neither is there any language in the cited passages that teaches that each proxy store is configured for receiving an associated initial quote response from its associated remote store site in reply to the first request, the initial quote response identifying at least some of the assets identified in the first request and associated prices. Neither is there any language in the cited passages that teaches that each proxy store is configured for

creating an associated initial quote list identifying the assets and associated prices identified in the initial quote response. Neither is there any language in the cited passages that teaches that each proxy store is configured for creating an associated initial quote list identifying the assets and associated prices identified in the initial quote response, the commerce site including an interface for presenting to the shopper client the initial quote lists associated with a plurality of the proxy stores. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 3, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Wharton and King, taken singly or in combination, do not teach or suggest "wherein an associated initial quote response can identify substitute assets and associated prices in place of at least some of the assets identified in the first request, each proxy store being configured to identify in the initial quote list associated therewith any substitute assets and associated prices identified in the initial quote response received by the proxy store, the commerce site interface permitting a client shopper to select assets and substitute assets from the presented initial quote lists, each proxy store being further configured for (c) creating an associated selection list identifying the assets and substitute assets selected by the client shopper from the initial quote list associated with the proxy store, and (d) sending the associated selection list over the computer network to the computer remote store associated therewith" as recited in claim 4. The Examiner cites paragraphs [0082-0085] of King as teaching the above-cited claim limitations. Office Action (9/29/2006), pages 9-10. Applicants respectfully traverse.

King instead teaches that to initiate an order, a registered buyer logs on to the marketplace 10, such as through the portal or website, using an industry standard Internet browser. [0080]. King further teaches that once on the marketplace 10, the buyer selects the ordering function. [0080]. King further teaches that the buyer submits the completed order, referred to as a 'Req Check' or a Price and Availability (P&A) Check, as an XML message to the marketplace 10. [0080]. King additionally teaches that the marketplace 10 receives the Req Check and records the line items

from the Req Check, so that the marketplace 10 can maintain the status of the buyer's order. [0081]. Furthermore, King teaches that the supplier manually or automatically responds to the Req Check. [0082]. Additionally, King teaches that the supplier creates an XML Req Check Response message and sends the message to the Omnexus Marketplace. [0082]. King further teaches that once received by the marketplace, the marketplace assesses the status of the message. [0083]. King additionally teaches that once the buyer receives the Req Check Response, the buyer either accepts the whole response, accepts some of the line items and rejects others, or restarts the Check Requisition process. [0084]. Furthermore, King teaches that once the Confirm Order message is received by the supplier, the supplier can accept the order, accept only certain line items and reject certain line items of the order or reject the entire order. [0085].

There is no language in the cited passages that teaches an associated initial quote response can identify substitute assets. Neither is there any language in the cited passages that teaches an associated initial quote response can identify substitute assets and associated prices. Neither is there any language in the cited passages that teaches an associated initial quote response can identify substitute assets and associated prices in place of at least some of the assets identified in the first request. Neither is there any language in the cited passages that teaches each proxy store being configured to identify in the initial quote list associated therewith any substitute assets and associated prices identified in the initial quote response received by the proxy store. Neither is there any language in the cited passages that teaches each proxy store being configured to identify in the initial quote list associated therewith any substitute assets and associated prices identified in the initial quote response received by the proxy store, the commerce site interface permitting a client shopper to select assets and substitute assets from the presented initial quote lists. Neither is there any language in the cited passages that teaches each proxy store being configured for creating an associated selection list identifying the assets and substitute assets selected by the client shopper from the initial quote list associated with the proxy store. Neither is there any language in the cited passages that teaches each proxy store being configured for sending the associated selection list over the computer

network to the computer remote store associated therewith. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 4, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Wharton and King, taken singly or in combination, do not teach or suggest "wherein the marketplace store is configured to assign a unique identifier to each asset listed in the parent list, each proxy store being configured to assign a correlation ID to each asset and substitute asset listed in the initial quote and selection lists thereby correlating the assets listed therein to assets listed in the parent list" as recited in claim 5. The Examiner cites paragraphs [0032-0033] of Wharton as teaching the above-cited claim limitations. Office Action (9/29/2006), page 10. Applicants respectfully traverse.

Wharton instead teaches that vendor commerce systems 34, 36, 38 are programmed to communicate transaction information to the ICC transaction processor 12 using a universal transaction interface comprising transaction packets 44. [0032]. Wharton further teaches that the ICC transaction processor 12 then stores this information in the global basket 14, pending global checkout by the customer 42. [0032]. Wharton additionally teaches that a variety of information may be included in each order entry, such as SKU number, product identification, quantity and price, to name a few. [0033].

There is no language in the cited passages that teaches that electronic mall 56 (Examiner asserts that electronic mall 56 teaches a marketplace store) is configured to assign a unique identifier to each asset listed in the parent list. Neither is there any language in the cited passages that teaches that each proxy store being configured to assign a correlation ID to each asset. Neither is there any language in the cited passages that teaches that each proxy store being configured to assign a correlation ID to each asset and substitute asset listed in the initial quote. Neither is there any language in the cited passages that teaches that each proxy store being configured to assign a correlation ID to each asset and substitute asset listed in the initial quote and selection lists. Neither is there any language in the cited passages that teaches that

each proxy store being configured to assign a correlation ID to each asset and substitute asset listed in the initial quote and selection lists thereby correlating the assets listed therein to assets listed in the parent list. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 5, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Wharton and King, taken singly or in combination, do not teach or suggest "wherein the parent list includes, for each identified asset, a desired quantity of the asset as selected by the shopper client, the proxy stores including the desired quantities in the first requests associated therewith" as recited in claim 6. The Examiner cites paragraph [0033] of Wharton as teaching the above-cited claim limitation. Office Action (9/29/2006), page 10. Applicants respectfully traverse.

Wharton instead teaches that included in the transaction packet are one or more order entries 44E, which indicate to the ICC transaction processor 12 what items are being purchased by the customer 42. [0033]. There is no language in the cited passage that teaches a parent list that includes for each identified asset, a desired quantity of the asset as selected by the shopper client. Instead, Wharton teaches a transaction packet that includes the quantity actually purchased by the customer. See [0032] and Figure 1 of Wharton. Neither is there any language in the cited passage that teaches a parent list that includes for each identified asset, a desired quantity of the asset as selected by the shopper client, the proxy stores including the desired quantities in the first requests associated therewith. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 6, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Wharton and King, taken singly or in combination, do not teach or suggest "the initial quote responses each identifying an available quantity of the assets identified therein, the available quantity being included in the presented initial quote lists, the commerce site interface permitting a

client shopper to select assets from the presented initial quote lists and specify an updated desired quantity of the selected assets, each proxy store being further configured for (c) creating an associated selection list identifying the assets selected by the client shopper from the initial quote list associated with the proxy store and the specified updated desired quantity thereof, and (d) sending the associated selection list over network to the remote store associated therewith" as recited in claim 6. The Examiner cites paragraphs [0082-0085] of King as teaching the above-cited claim limitations. Office Action (9/29/2006), pages 10-11.

King instead teaches that the supplier manually or automatically responds to the Req Check. [0082]. Additionally, King teaches that the supplier creates an XML Req Check Response message and sends the message to the Omnexus Marketplace. [0082]. King further teaches that once received by the marketplace, the marketplace assesses the status of the message. [0083]. King additionally teaches that once the buyer receives the Req Check Response, the buyer either accepts the whole response, accepts some of the line items and rejects others, or restarts the Check Requisition process. [0084]. Furthermore, King teaches that once the Confirm Order message is received by the supplier, the supplier can accept the order, accept only certain line items and reject certain line items of the order or reject the entire order. [0085].

There is no language in the cited passages that teaches that the initial quote responses each identifying an available quantity of the assets identified therein. Neither is there any language in the cited passages that teaches that the initial quote responses each identifying an available quantity of the assets identified therein, the available quantity being included in the presented initial quote lists. Neither is there any language in the cited passages that teaches that the initial quote responses each identifying an available quantity of the assets identified therein, the available quantity being included in the presented initial quote lists, the commerce site interface permitting a client shopper to select assets from the presented initial quote lists and specify an updated desired quantity of the selected assets. Neither is there any language in the cited passages that teaches each proxy store being further configured for creating an associated selection list identifying the assets selected by the client shopper from the initial quote list associated with the proxy store. Neither is there

any language in the cited passages that teaches each proxy store being further configured for creating an associated selection list identifying the assets selected by the client shopper from the initial quote list associated with the proxy store and the specified updated desired quantity thereof. Neither is there any language in the cited passages that teaches each proxy store being further configured for sending the associated selection list over network to the remote store associated therewith. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 6, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Wharton and King, taken singly or in combination, do not teach or suggest "wherein the initial quote responses include a projected availability date for the assets identified therein and a quantity of the asset available on the availability date" as recited in claim 7. The Examiner cites paragraphs [0080-0082] of King as teaching the above-cited claim limitation. Office Action (9/29/2006), page 11. Applicants respectfully traverse.

King instead teaches that to initiate an order, a registered buyer logs on to the marketplace 10, such as through the portal or website, using an industry standard Internet browser. [0080]. King further teaches that once on the marketplace 10, the buyer selects the ordering function. [0080]. King further teaches that the buyer submits the completed order, referred to as a 'Req Check' or a Price and Availability (P&A) Check, as an XML message to the marketplace 10. [0080]. King additionally teaches that the marketplace 10 receives the Req Check and records the line items from the Req Check, so that the marketplace 10 can maintain the status of the buyer's order. [0081]. Furthermore, King teaches that the supplier manually or automatically responds to the Req Check. [0082]. Additionally, King teaches that the supplier creates an XML Req Check Response message and sends the message to the Omnexus Marketplace. [0082].

There is no language in the cited passages that teaches an initial quote responses that include a projected availability date for the assets identified therein. Neither is there any language in the cited passages that teaches an initial quote

responses that include a projected availability date for the assets identified therein and a quantity of the asset available on the availability date. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 7, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Wharton and King, taken singly or in combination, do not teach or suggest "sending the associated selection list over network to the remote store associated therewith" as recited in claim 8. The Examiner cites paragraph [0033] of Wharton as teaching the above-cited claim limitation. Office Action (9/29/2006), page 12. The Examiner further cites paragraph [0095] of King as teaching the above-cited claim limitation. Office Action (9/29/2006), page 12. Applicants respectfully traverse.

Wharton instead teaches that also included in the transaction packet are one or more order entries 44E, which indicate to the ICC transaction processor 12 what items are being purchased by the customer 42. [0033].

King instead teaches that buyer has the option of enabling the order to be processed to completion if it can be fulfilled as requested or if it can be fulfilled with the best alternative. [0095].

There is no language in the cited passages that teaches sending the associated selection list (referring to the associated selection list identifying the assets selected by the client shopper from the initial quote list associated with the proxy store) over network to the remote store associated therewith. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 8, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Wharton and King, taken singly or in combination, do not teach or suggest "the commerce site interface permitting a client shopper to select assets from the presented initial quote lists, each proxy store being further configured for (c) creating an associated selection list identifying the assets selected by the client shopper from the initial quote list associated with the proxy

store" as recited in claim 8. The Examiner cites paragraphs [0084-0085] of King as teaching the above-cited claim limitations. Office Action (9/29/2006), page 11. Applicants respectfully traverse.

King instead teaches that once the buyer receives the Req Check Response, the buyer either accepts the whole response, accepts some of the line items and rejects others, or restarts the Check Requisition process. [0084]. King further teaches that once the confirm order message is received by the supplier, the supplier can accept the order, accept only certain line items and reject certain line items of the order, or reject the entire order. [0085].

There is no language in the cited passages that teaches a commerce site interface permitting a client shopper to select assets from the presented initial quote lists, each proxy store being further configured for creating an associated selection list identifying the assets selected by the client shopper from the initial quote list associated with the proxy store. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 8, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Wharton and King, taken singly or in combination, do not teach or suggest "each proxy store further configured for (e) receiving an associated further quote response from its associated remote store site in reply to the selection list, the further quote response identifying the assets identified in the selection list and associated prices, and (f) creating an associated further quote list identifying the assets and associated prices identified in the further quote response; the commerce site interface configured for presenting to the shopper client the further quote lists" as recited in claim 9. The Examiner cites paragraph [0085] of King as teaching the above-cited claim limitation. Office Action (9/29/2006), page 12. Applicants respectfully traverse.

King instead teaches that once the confirm order message is received by the supplier, the supplier can accept the order, accept only certain line items and reject certain line items of the order; or reject the entire order. [0085]. There is no

language in the cited passage that teaches that each proxy store is configured for receiving an associated further quote response from its associated remote store site in reply to the selection list. Neither is there any language in the cited passage that teaches that each proxy store is configured for receiving an associated further quote response from its associated remote store site in reply to the selection list, the further quote response identifying the assets identified in the selection list and associated prices. Neither is there any language in the cited passage that teaches that each proxy store is configured for creating an associated further quote list identifying the assets and associated prices identified in the further quote response. Neither is there any language in the cited passage that teaches that each proxy store is configured for creating an associated further quote list identifying the assets and associated prices identified in the further quote response; the commerce site interface configured for presenting to the shopper client the further quote lists. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 9, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Wharton and King, taken singly or in combination, do not teach or suggest "the commerce site interface permitting a client shopper to select assets from the presented further quote lists, each proxy store being further configured for (g) updating the associated selection list associated therewith to identify the assets selected by the client shopper from the further quote list associated with the proxy store, and (h) sending the updated selection list over network to the remote store associated therewith" as recited in claim 10. The Examiner cites paragraphs [0107-0109] of King as teaching the above-cited claim limitation. Office Action (9/29/2006), page 12. Applicants respectfully traverse.

King instead teaches that the buyer can create an order either manually or automatically. [0107]. King further teaches that through the confirm order response process 34, a supplier provides final acceptance or cancellation of line items. [0109].

There is no language in the cited passages that teaches a commerce site interface permitting a client shopper to select assets from the presented further quote

lists, each proxy store being further configured for updating the associated selection list associated therewith to identify the assets selected by the client shopper from the further quote list associated with the proxy store. Neither is there any language in the cited passages that teaches that each proxy store being further configured for sending the updated selection list over network to the remote store associated therewith. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 10, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Wharton and King, taken singly or in combination, do not teach or suggest "wherein each proxy store is configured to receive status information from the remote store associated therewith about orders for assets submitted to the remote store associated therewith, the commerce site including an interface for presenting the status information to a requesting shopper client" as recited in claim 12. The Examiner cites paragraph [0086] of King as teaching the above-cited claim limitation. Office Action (9/29/2006), page 13. Applicants respectfully traverse and assert that King instead teaches that a change order via the marketplace can be initiated by the buyer or the supplier. [0086]. King further teaches that the change order process is very similar to the ordering process. [0086]. King additionally teaches that when the supplier ships the product to the buyer, an XML message is sent to the marketplace. [0086]. There is no language in the cited passage that teaches that each proxy store is configured to receive status information from the remote store associated therewith about orders for assets submitted to the remote store associated therewith. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 12, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Wharton and King, taken singly or in combination, do not teach or suggest "receiving at the proxy stores from the remote store sites associated therewith a first quote response identifying quote prices for at least some of the assets identified in the first requests; and generating at each proxy store receiving a first quote response an associated first child object that includes a

list of first quote items, each first quote item including: (i) an asset identifier identifying a quoted asset for which a first quote has been received, (ii) the quote price for the quoted asset, (iii) an available quantity of the quoted asset, and (iv) a correlation ID linking the first quote item to a corresponding one of the parent items" as recited in claim 15. The Examiner states that the limitations of claim 15 are closely parallel to the limitations of claim 3 and hence are rejected for similar reasons. Office Action (9/29/2006), page 13. However, claim 15 recites limitations that are not closely parallel to the limitations of claim 3. Applicants respectfully request the Examiner to particularly point out where these limitations are taught or suggested by Wharton and/or King pursuant to 37 C.F.R. §1.104(c)(2). Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 15, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Wharton and King, taken singly or in combination, do not teach or suggest "h) presenting through the marketplace commerce site information included in the first child objects generated by the proxy stores and accepting shopper selections of assets identified in the first child objects; i) generating the proxy stores associated second child objects that each include a list of selected items identifying the assets and a quantity thereof selected by the shopper from the first child object associated with the proxy store; and j) sending further requests from the proxy stores to the associated remote store sites, the further request from each proxy store including identification of selected assets and the quantity thereof from the associated second child object" as recited in claim 16. The Examiner states that the limitations of claim 16 are closely parallel to the limitations of claim 4 and hence are rejected for similar reasons. Office Action (9/29/2006), page 13. However, claim 16 recites limitations that are not closely parallel to the limitations of claim 4. Applicants respectfully request the Examiner to particularly point out where these limitations are taught or suggested by Wharton and/or King pursuant to 37 C.F.R. §1.104(c)(2). Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 16, since the Examiner is relying upon incorrect,

factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Wharton and King, taken singly or in combination, do not teach or suggest "receiving at proxy stores from the remote store sites associated therewith status information about previous orders for assets made to the associated remote store sites" as recited in claim 17. The Examiner states that the limitations of claim 17 are closely parallel to the limitations of claim 12 and hence are rejected for similar reasons. Office Action (9/29/2006), page 13. However, claim 17 recites limitations that are not closely parallel to the limitations of claim 12. Applicants respectfully request the Examiner to particularly point out where these limitations are taught or suggested by Wharton and/or King pursuant to 37 C.F.R. §1.104(c)(2). Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 17, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

As a result of the foregoing, Applicants respectfully assert that there are numerous claim limitations not taught or suggested in Wharton in view of King, and thus the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 3-10, 12 and 15-17. M.P.E.P. §2143.

2. Examiner's motivation for modifying Wharton with King to include the missing claim limitations of claim 3 is insufficient to establish a *prima facie* case of obviousness.

Most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of

the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner admits that Wharton does not teach the limitations of claim 3. Office Action (9/29/2006), page 8. The Examiner asserts that King teaches the limitations of claim 3. Office Action (9/29/2006), pages 8-9. The Examiner's motivation for modifying Wharton with King to include the limitations of claim 3 is "doing so would allow for a buyer to inquire into the price and availability of goods in order to make a more informed buying decision, and therefore increase customer satisfaction, as suggested by King ([¶¶] 0004 and 0008)." Office Action (9/29/2006), page 9. The Examiner's motivation is insufficient to establish a *prima facie* case of obviousness in rejecting claim 3.

The Examiner' motivation ("doing so would allow for a buyer to inquire into the price and availability of goods in order to make a more informed buying decision, and therefore increase customer satisfaction") does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Wharton to include the missing claim limitations of claim 3. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claim 3. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

As stated above, the Examiner cites paragraphs [0004 and 0008] of King as support for the motivation for modifying Wharton to include the missing claim limitations of claim 3. King teaches that many of the exchanges between buyers and sellers described in these patents are of limited practice use. [0004]. King further teaches that as a result, many of these on-line marketplaces do not provide a practical

solution between the exchanges between buyers and sellers. [0004]. King additionally discloses that the invention addresses the above problems by providing systems and methods for creating on-line marketplaces. [0008]. King further teaches that according to one aspect of the invention, the marketplace permits a buyer to issue a requisition check inquiring into at least one of the price and availability of the goods. [0008]. Hence, King teaches an online marketplace permitting a buyer to issue a requisition check inquiring into at least one of the price and availability of the goods.

How does having an online marketplace permitting a buyer to issue a requisition check inquiring into at least one of the price and availability of the goods relate to the limitations of claim 3 (namely, wherein each proxy store is configured for (a) receiving an associated initial quote response from its associated remote store site in reply to the first request, the initial quote response identifying at least some of the assets identified in the first request and associated prices, and (b) creating an associated initial quote list identifying the assets and associated prices identified in the initial quote response, the commerce site including an interface for presenting to the shopper client the initial quote lists associated with a plurality of the proxy stores)? That is, how does having an online marketplace permitting a buyer to issue a requisition check inquiring into at least one of the price and availability of the goods relate to having each proxy store configured for receiving an associated initial quote response from its associated remote store site in reply to the first request, the initial quote response identifying at least some of the assets identified in the first request and associated prices? Further, how does having an online marketplace permitting a buyer to issue a requisition check inquiring into at least one of the price and availability of the goods relate to having each proxy store configured for creating an associated initial quote list identifying the assets and associated prices identified in the initial quote response, the commerce site including an interface for presenting to the shopper client the initial quote lists associated with a plurality of the proxy stores? How do the passages cited by the Examiner as support for the Examiner's motivation provide reasons as why one skilled in the art would modify Wharton to include the missing claim limitations of claim 3? The passages cited by the Examiner provide no reasons as to why one skilled in the art would modify Wharton to include the missing

claim limitations of claim 3. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claim 3. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Further, Wharton addresses the problem of providing an e-commerce framework that satisfies the needs of customers by providing a single, unified shopping experience, that also satisfies the needs of vendors by allowing them to retain control of their product and customer databases while relieving them of the logistical difficulties in operating an e-commerce system. [0008]. The Examiner has not provided any reasons as to why one skilled in the art would modify Wharton (which teaches providing a single, unified shopping experience, that also satisfies the needs of vendors by allowing them to retain control of their product and customer databases while relieving them of the logistical difficulties in operating an e-commerce system) to have each proxy store configured for (a) receiving an associated initial quote response from its associated remote store site in reply to the first request, the initial quote response identifying at least some of the assets identified in the first request and associated prices, and (b) creating an associated initial quote list identifying the assets and associated prices identified in the initial quote response, the commerce site including an interface for presenting to the shopper client the initial quote lists associated with a plurality of the proxy stores (missing claim limitations of Wharton). The Examiner's motivation ("doing so would allow for a buyer to inquire into the price and availability of goods in order to make a more informed buying decision, and therefore increases customer satisfaction") does not provide such reasoning.

Why would the reason to modify Wharton, whose purpose is to provide an e-commerce framework that satisfies the needs of customers by providing a single, unified shopping experience, that also satisfies the needs of vendors by allowing them to retain control of their product and customer databases while relieving them of the logistical difficulties in operating an e-commerce system, to have each proxy store configured for (a) receiving an associated initial quote response from its associated remote store site in reply to the first request, the initial quote response identifying at least some of the assets identified in the first request and associated prices (missing claim limitation of claim 3) be to allow for a buyer to inquire into the price and

availability of goods in order to make a more informed buying decision, and therefore increase customer satisfaction? Why would the reason to modify Wharton, whose purpose is to provide an e-commerce framework that satisfies the needs of customers by providing a single, unified shopping experience, that also satisfies the needs of vendors by allowing them to retain control of their product and customer databases while relieving them of the logistical difficulties in operating an e-commerce system, to have each proxy store configured for creating an associated initial quote list identifying the assets and associated prices identified in the initial quote response, the commerce site including an interface for presenting to the shopper client the initial quote lists associated with a plurality of the proxy stores (missing claim limitation of claim 3) be to allow for a buyer to inquire into the price and availability of goods in order to make a more informed buying decision, and therefore increase customer satisfaction? How does this motivation provide reasons for the person skilled in the art to modify Wharton to include the missing claim limitations of claim 3? Hence, the Examiner's motivation does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Wharton to include the missing claim limitations of claim 3. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claim 3. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

3. Examiner's motivation for modifying Wharton with King to include the missing claim limitations of claim 4 is insufficient to establish a *prima facie* case of obviousness.

As stated above, most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same

problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner admits that Wharton does not teach the limitations of claim 4. Office Action (9/29/2006), page 8. The Examiner asserts that King teaches the limitations of claim 4. Office Action (9/29/2006), page 9. The Examiner's motivation for modifying Wharton with King to include the limitations of claim 4 is "in order to provide a more real-life shopping experience by allowing the customer to see and possible choose substitutions for products not in stock, thereby increasing the possibility of sales and of customer satisfaction." Office Action (9/29/2006), page 10. The Examiner's motivation is insufficient to establish a *prima facie* case of obviousness in rejecting claim 4.

The Examiner has not provided a source for his motivation for modifying Wharton to include the claim limitations of claim 4. The Examiner simply states "in order to provide a more real-life shopping experience by allowing the customer to see and possible choose substitutions for products not in stock, thereby increasing the possibility of sales and of customer satisfaction" as motivation for modifying Wharton to include the above-cited claim limitations. The motivation to modify Wharton must come from one of three possible sources: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457-48 (Fed. Cir. 1998). Applicants respectfully request the Examiner to point out which of

these sources is the source of the Examiner's motivation². The Examiner has not provided any evidence that his motivation comes from any of these sources. Instead, the Examiner is relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claim 4. *Id.*

4. Examiner's motivation for modifying Wharton with King to include the missing claim limitations of claim 6 is insufficient to establish a *prima facie* case of obviousness.

As stated above, most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole

² Applicants feel it is very important for the Examiner to point out the source of the Examiner's motivation because it appears to Applicants that the Examiner is relying upon his own subjective opinion. The reason why the Federal Circuit (*In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2000)) has required the Examiner to provide objective evidence is because it may be easy to conclude that it would be obvious to combine references using hindsight reasoning even though there is no motivation or suggestion to do so. One can usually find a reason to combine references or make modifications to the main reference. If that were all it took, then all inventions would be obvious and not patentable. For example, assuming that a wheelbarrow had never been developed and a patentee had claimed a wheelbarrow, if the main reference taught a cart with a shallow box body, and the secondary reference taught two wheels, then the Examiner could simply assert, using hindsight reasoning without providing objective evidence, that the motivation for combining the two references is so that the cart could be moved from place to place. Hence, the patentee could not obtain a patent on the wheelbarrow (even though one has never been developed) based on the Examiner's rationale for combining the references. Yet the Examiner has not provided any evidence that a person of ordinary skill in the art would have combined the references to make such a product. In hindsight, everything is obvious. It seems that a question that should be asked is why the invention (in this example a wheelbarrow) was not already developed. If it is so obvious, then it would seem it already would have been developed.

claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner admits that Wharton does not teach the limitations of claim 6. Office Action (9/29/2006), page 10. The Examiner asserts that King teaches the limitations of claim 6. Office Action (9/29/2006), pages 10-11. The Examiner's motivation for modifying Wharton with King to include the limitations of claim 4 is "in order to provide a more real-life shopping experience by allowing the customer to see and possible choose substitutions for products not in stock, thereby increasing the possibility of sales and of customer satisfaction." Office Action (9/29/2006), page 11. The Examiner's motivation is insufficient to establish a *prima facie* case of obviousness in rejecting claim 6.

The Examiner has not provided a source for his motivation for modifying Wharton to include the claim limitations of claim 6. The Examiner simply states "in order to provide a more real-life shopping experience by allowing the customer to see and possible choose substitutions for products not in stock, thereby increasing the possibility of sales and of customer satisfaction" as motivation for modifying Wharton to include the above-cited claim limitations. The motivation to modify Wharton must come from one of three possible sources: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-48 (Fed. Cir. 1998). Applicants respectfully request the Examiner to point out which of

these sources is the source of the Examiner's motivation. The Examiner has not provided any evidence that his motivation comes from any of these sources. Instead, the Examiner is relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claim 6. *Id.*

Further, the Examiner' motivation ("in order to provide a more real-life shopping experience by allowing the customer to see and possible choose substitutions for products not in stock, thereby increasing the possibility of sales and of customer satisfaction") does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Wharton to include the missing claim limitations of claim 6. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claim 6. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Wharton addresses the problem of providing an e-commerce framework that satisfies the needs of customers by providing a single, unified shopping experience, that also satisfies the needs of vendors by allowing them to retain control of their product and customer databases while relieving them of the logistical difficulties in operating an e-commerce system. [0008]. The Examiner has not provided any reasons as to why one skilled in the art would modify Wharton (which teaches providing a single, unified shopping experience, that also satisfies the needs of vendors by allowing them to retain control of their product and customer databases while relieving them of the logistical difficulties in operating an e-commerce system) to have the initial quote responses each identifying an available quantity of the assets identified therein, the available quantity being included in the presented initial quote lists, the commerce site interface permitting a client shopper to select assets from the presented initial quote lists and specify an updated desired quantity of the selected assets, each proxy store being further configured for (c) creating an associated selection list identifying the assets selected by the client shopper from the initial quote list associated with the proxy store and the specified updated desired quantity

thereof, and (d) sending the associated selection list over network to the remote store associated therewith (missing claim limitations of Wharton). The Examiner's motivation ("in order to provide a more real-life shopping experience by allowing the customer to see and possible choose substitutions for products not in stock, thereby increasing the possibility of sales and of customer satisfaction") does not provide such reasoning.

Why would the reason to modify Wharton (whose purpose is to provide an e-commerce framework that satisfies the needs of customers by providing a single, unified shopping experience, that also satisfies the needs of vendors by allowing them to retain control of their product and customer databases while relieving them of the logistical difficulties in operating an e-commerce system) to have the initial quote responses each identifying an available quantity of the assets identified therein, the available quantity being included in the presented initial quote lists, the commerce site interface permitting a client shopper to select assets from the presented initial quote lists and specify an updated desired quantity of the selected assets, each proxy store being further configured for (c) creating an associated selection list identifying the assets selected by the client shopper from the initial quote list associated with the proxy store and the specified updated desired quantity thereof, and (d) sending the associated selection list over network to the remote store associated therewith (missing claim limitations of Wharton) be to provide a more real-life shopping experience by allowing the customer to see and possible choose substitutions for products not in stock, thereby increasing the possibility of sales and of customer satisfaction? The missing claim limitations of claim 6 do not recite limitations related to substitutions. Hence, the Examiner's motivation does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Wharton to include the missing claim limitations of claim 6. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claim 6. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

5. Examiner's motivation for modifying Wharton with King to include the missing claim limitations of claim 7 is insufficient to establish a *prima facie* case of obviousness.

As stated above, most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner admits that Wharton does not teach "wherein the initial quote responses include a projected availability data for the assets identified therein and a quantity of the asset available on the availability date" as recited in claim 7. Office Action (9/29/2006), page 11. The Examiner asserts that King teaches the above-cited claim limitation. Office Action (9/29/2006), page 11. The Examiner's motivation for modifying Wharton with King to include the above-cited claim limitation is "in order for customers to make a more informed decision as to whether their requirements are met, including delivery requirements, thereby better replicating a more realistic negotiation between customers and suppliers, as suggested by King (§0004)." Office Action (9/29/2006), page 11. The Examiner's motivation is insufficient to establish a *prima facie* case of obviousness in rejecting claim 3.

As stated above, the Examiner cites paragraph [0004] of King as support for the motivation for modifying Wharton to include the missing claim limitation of

"wherein the initial quote responses include a projected availability data for the assets identified therein and a quantity of the asset available on the availability date" as recited in claim 7. King teaches that many of the exchanges between buyers and sellers described in these patents are of limited practice use. [0004]. King further teaches that as a result, many of these on-line marketplaces do not provide a practical solution between the exchanges between buyers and sellers. [0004]. There is absolutely no language in paragraph [0004] of King that makes any suggestion of having an initial quote response to include a projected availability date for the assets identifier therein and a quantity of the asset available on the availability date in order for customers to make a more informed decision as to whether their requirements are met, including delivery requirements, thereby better replicating a more realistic negotiation between customers and suppliers. Applicants respectfully request the Examiner to particularly point out where in paragraph [0004] of King there is such a suggestion pursuant to 37 C.F.R. §1.104(c)(2).

Further, the Examiner's motivation appears to have been gleaned only from Applicants' disclosure, such as for example on page 13, line 10 – page 14, line 16 of Applicants' Specification. Any judgment on obviousness must not include knowledge gleaned only from Applicants' disclosure. *In re McLaughlin*, 170 U.S.P.Q. 209, 212 (C.C.P.A. 1971). Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claim 7. M.P.E.P. §2145.

6. Examiner's motivation for modifying Wharton with King to include the missing claim limitations of claim 8 is insufficient to establish a *prima facie* case of obviousness.

As stated above, most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same

problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner admits that Wharton does not teach "the commerce site interface permitting a client shopper to select assets from the presented initial quote lists, each proxy store being further configured for (c) creating an associated selection list identifying the assets selected by the client shopper from the initial quote list associated with the proxy store" as recited in claim 8. Office Action (9/29/2006), page 11. The Examiner asserts that King teaches above-cited claim limitations. Office Action (9/29/2006), page 11. The Examiner's motivation for modifying Wharton with King to include the above-cited claim limitations is "in order to create an order for the products and consummate the sale." Office Action (9/29/2006), page 12. The Examiner's motivation is insufficient to establish a *prima facie* case of obviousness in rejecting claim 8.

The Examiner has not provided a source for his motivation for modifying Wharton to include the above-cited claim limitations. The Examiner simply states "in order to create an order for the products and consummate the sale" as motivation for modifying Wharton to include the above-cited claim limitations. The motivation to modify Wharton must come from one of three possible sources: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-48 (Fed. Cir. 1998). Applicants respectfully request the Examiner to point out which of these sources is the source of the Examiner's motivation. The Examiner has not provided any evidence that his motivation comes from any of these sources.

Instead, the Examiner is relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claim 8. *Id.*

Further, the Examiner's motivation ("in order to create an order for the products and consummate the sale") does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Wharton to include the missing claim limitations of claim 8. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claim 8. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

The above-cited claim limitations are directed to more than just creating an order as the Examiner's motivation implies. Instead, the above-cited claim limitations state "the commerce site interface permitting a client shopper to select assets from the presented initial quote lists, each proxy store being further configured for (c) creating an associated selection list identifying the assets selected by the client shopper from the initial quote list associated with the proxy store." What is the reason why Wharton would be modified to include such limitations? Since the Examiner has not provided any reasons as to why one skilled in the art would modify Wharton to include the missing claim limitations of claim 8, the Examiner has not presented a *prima facie* case of obviousness for rejecting claim 8. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

7. Examiner's motivation for modifying Wharton with King to include the missing claim limitations of claim 9 is insufficient to establish a *prima facie* case of obviousness.

As stated above, most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole

claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner admits that Wharton does not teach the limitations of claim 9. Office Action (9/29/2006), page 12. The Examiner asserts that King teaches the limitations of claim 9. *Id.* The Examiner's motivation for modifying Wharton with King to include the limitations of claim 9 is "thereby replicating a more realistic negotiation between customers and suppliers, as suggested by King (§0004)." *Id.* The Examiner's motivation is insufficient to establish a *prima facie* case of obviousness in rejecting claim 9.

As stated above, the Examiner cites paragraph [0004] of King as support for the motivation for modifying Wharton to include the missing claim limitations of claim 9. King teaches that many of the exchanges between buyers and sellers described in these patents are of limited practice use. [0004]. King further teaches that as a result, many of these on-line marketplaces do not provide a practical solution between the exchanges between buyers and sellers. [0004]. Hence, King teaches an online marketplace permitting a buyer to issue a requisition check inquiring into at least one of the price and availability of the goods.

There is no language in [0004] of King that would suggest to one skilled in the art to modify Wharton to have each proxy store further configured for: receiving an associated further quote response from its associated remote store site in reply to the selection list, the further quote response identifying the assets identified in the

selection list and associated prices, and creating an associated further quote list identifying the assets and associated prices identified in the further quote response; the commerce site interface configured for presenting to the shopper client the further quote lists, as recited in claim 9, in order to thereby replicating a more realistic negotiation between customers and suppliers. Where are the reasons in [0004] of King that would cause one skilled in the art to modify Wharton to include the missing claim limitations of claim 9?

The Examiner' motivation does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Wharton to include the missing claim limitations of claim 9. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claim 9. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

8. Examiner's motivation for modifying Wharton with King to include the missing claim limitations of claim 10 is insufficient to establish a *prima facie* case of obviousness.

As stated above, most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed.

Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner admits that Wharton does not teach the limitations of claim 10. Office Action (9/29/2006), page 12. The Examiner asserts that King teaches the limitations of claim 9. *Id.* The Examiner's motivation for modifying Wharton with King to include the limitations of claim 10 is "in order for customers to better order what they desire and to better replicate a more realistic negotiation between customers and suppliers, as suggested by King ([0004])." *Id.* The Examiner's motivation is insufficient to establish a *prima facie* case of obviousness in rejecting claim 10.

As stated above, the Examiner cites paragraph [0004] of King as support for the motivation for modifying Wharton to include the missing claim limitations of claim 10. King teaches that many of the exchanges between buyers and sellers described in these patents are of limited practice use. [0004]. King further teaches that as a result, many of these on-line marketplaces do not provide a practical solution between the exchanges between buyers and sellers. [0004]. Hence, King teaches an online marketplace permitting a buyer to issue a requisition check inquiring into at least one of the price and availability of the goods.

There is no language in [0004] of King that would suggest to one skilled in the art to modify Wharton to have a commerce site interface permitting a client shopper to select assets from the presented further quote lists, each proxy store being further configured for: updating the associated selection list associated therewith to identify the assets selected by the client shopper from the further quote list associated with the proxy store, and sending the updated selection list over network to the remote store associated therewith, as recited in claim 10, in order for customers to better order what they desire and to better replicate a more realistic negotiation between customers and suppliers. Where are the reasons in [0004] of King that would cause one skilled in the art to modify Wharton to include the missing claim limitations of claim 10?

The Examiner' motivation does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Wharton to include the missing claim limitations of claim 10. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claim 10. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

B. Claims 3-10, 12 and 15-17 are patentable over Wharton in view of King.

1. Wharton and Palmer, taken singly or in combination, do not teach or suggest the following claim limitations.

Applicants respectfully assert that Wharton and Palmer, does not teach or suggest "wherein each proxy store is configured for receiving and storing inventory information received from the remote store associated therewith" as recited in claim 13. The Examiner cites paragraphs [0047-0048] of Palmer as teaching the above-cited claim limitation. Office Action (9/29/2006), page 13. Applicants respectfully traverse and assert that Palmer instead teaches that the data within the above XML document includes values associated with the following predefined elements: part, part number, and quantity available. [0047]. Palmer further teaches that the parts inventory data is received by the availability engine, and processed to determine product availability information. [0048]. Palmer further teaches that product availability information is broadly defined to encompass any information that indicates whether a product is available from a supplier. [0048]. There is no language in the cited passages that teaches that each proxy store is configured for receiving and storing inventory information. Neither is there any language in the cited passages that teaches that each proxy store is configured for receiving and storing inventory information received from the remote store associated therewith. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 13, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Wharton and Palmer, does not teach or suggest "receiving at proxy stores from the remote store sites associated therewith inventory

information about assets available through the associated remote store sites, and storing the received inventory information at the marketplace commerce site" as recited in claim 18. The Examiner cites paragraphs [0047-0048] of Palmer as teaching the above-cited claim limitation. Office Action (9/29/2006), page 13. Applicants respectfully traverse and assert that Palmer instead teaches that the data within the above XML document includes values associated with the following predefined elements: part, part number, and quantity available. [0047]. Palmer further teaches that the parts inventory data is received by the availability engine, and processed to determine product availability information. [0048]. Palmer further teaches that product availability information is broadly defined to encompass any information that indicates whether a product is available from a supplier. [0048]. There is no language in the cited passages that teaches receiving at proxy stores from the remote store sites associated therewith inventory information about assets available through the associated remote store sites. Neither is there any language in the cited passages that teaches storing the received inventory information at the marketplace commerce site. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 18, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

2. Examiner's motivation for modifying Wharton with Palmer to include the missing claim limitations of claims 13 and 18 is insufficient to establish a *prima facie* case of obviousness.

As stated above, most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would

select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner admits that Wharton does not teach the limitations of claims 13 and 18. Office Action (9/29/2006), pages 13-14. The Examiner asserts that Palmer teaches the limitations of claims 13 and 18. *Id.* The Examiner's motivation for modifying Wharton with Palmer to include the limitations of claims 13 and 18 is "doing so would allow for customers to obtain accurate availability information in an efficient manner, as suggested by Palmer (¶0007)." *Id.* The Examiner's motivation is insufficient to establish a *prima facie* case of obviousness in rejecting claims 13 and 18.

As stated above, the Examiner cites paragraph [0007] of Palmer as support for the motivation for modifying Wharton to include the missing claim limitations of claims 13 and 18. Palmer teaches that in a related embodiment a process in a system for determining availability of a configurable product preferably includes receiving a product number from a client through the internet, generating a parts list corresponding to the product number, obtaining parts lists corresponding to the product number, obtaining parts inventory data for the parts included in the parts list from supplier parts databases, determining product availability information for each of the suppliers using the parts lists and the supplier's inventory data, and providing the availability information for each of the suppliers to the client through the internet. [0007].

There is no language in [0007] of Palmer that would suggest to one skilled in the art to modify Wharton to: (1) have each proxy store be configured for receiving and storing inventory information received from the remote store associated

therewith, as recited in claim 13, and (2) receive at proxy stores from the remote store sites associated therewith inventory information about assets available through the associated remote store sites, and store the received inventory information at the marketplace commerce site, as recited in claim 18, because doing so would allow for customers to obtain accurate availability information in an efficient manner. Where are the reasons in [0007] of Palmer that would cause one skilled in the art to modify Wharton to include the missing claim limitations of claims 13 and 18?

The Examiner' motivation does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Wharton to include the missing claim limitations of claims 13 and 18. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 13 and 18. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

V. CONCLUSION:

As a result of the foregoing, it is asserted by Applicants that claims 1-19 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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